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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
10/717,693	11/20/2003	Hai H. Tricu	4002-3430/PC775.01	9321								
<div>7590 06/27/2007 Woodard, Emhardt, Moriarty, McNett & Henry LLP Bank One Center/Tower Suite 3700 111 Monument Circle Indianapolis, IN 46204-5137</div>			<div>EXAMINER RAMANA, ANURADHA</div> <table border="1"><thead><tr><th>ART UNIT</th><th>PAPER NUMBER</th></tr></thead><tbody><tr><td>3733</td><td></td></tr></tbody></table> <div><table border="1"><thead><tr><th>MAIL DATE</th><th>DELIVERY MODE</th></tr></thead><tbody><tr><td>06/27/2007</td><td>PAPER</td></tr></tbody></table></div>		ART UNIT	PAPER NUMBER	3733		MAIL DATE	DELIVERY MODE	06/27/2007	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/717,693		TRIEU	
	Examiner		Art Unit	
	Anu Ramana		3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 1-36, 53, 54, 66 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-52 and 55-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/20/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/20/04; 6/28/04; 11/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species I (Figures 1-20) and group II (claims 37-67) in the response filed on April 24, 2007 is noted.

The traversal is on the grounds that the entire case can be searched without significant additional burden on the Examiner. This is not found to be persuasive because the search for patentably distinct subject matter requires different search queries. Furthermore, execution of a comprehensive search of all method and system claims in the instant application would not only constitute an undue burden on the Examiner, but consideration of the findings of such a search for patentability determination of the claims would be unduly onerous. It is also noted that a comprehensive search for the presently claimed subject matter is not solely limited to a search of the classes and subclasses in which they are classified.

Regarding Applicant's arguments on pages 2 and 3, it is noted that claim 19 is directed to a patentably distinct invention from each of claims 37 and 55. The system of claim 37 and 55 could be used in a method that does not require the expandable device to maintain an intervertebral spacing.

The arguments with respect to the election of species are not found to be persuasive since MPEP §803 explicitly refers to MPEP §806.04(a) when attempting to define what the term "serious burden" constitutes. This section of the MPEP refers to rule 37 CFR 1.141 for guidance. Rule 37 CFR 1.141 states that more than one species may be claimed provided the application also contains an allowable claim generic to all the claimed species and all the claims to the species in excess of one are written in dependent form (§1.75) or otherwise include all the limitations of the allowable generic claim. Since this is clearly not the case as evidenced by the rejections in this action, the requirement stands.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-36, 53-54, 66 and 67 are withdrawn from further consideration since they are directed to non-elected inventions and species. This office action addresses claims 37-52 and 55-65 on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 37, 41, 43-46, 48, 55, 57-60, 64 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Foley et al. (US 2002/0026197 A1).

Foley et al. disclose a system for intervertebral disc repair including: a delivery instrument 222; an expandable element (254, 256) at a distal end thereof; and an expandable device 232a at a distal end thereof removably mountable to the expandable element (Figs. 7-8 and paras [0053]-[0061])).

Claims 37, 41-52 and 55-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Sertich (US 5,800,550).

Sertich discloses a system for intervertebral disc repair including: a delivery instrument 98; an expandable element 112 at a distal end thereof; and an expandable device 32 removably mountable to the expandable element wherein the expandable device has a cavity 44 that can be packed with bone filler (Figs. 1A, 3 and 7B, cols. 5-9 and col. 10, lines 1-27).

Claims 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated Felt et al. (US 6,306,177).

Felt et al. disclose a system for intervertebral disc repair including: a delivery instrument 10, an expandable element 12 at a distal end thereof; and an expandable device 26 removably mountable to the expandable element wherein the expandable element includes a balloon with an interior configured to receive an expansion fluid (Figs. 1-4, col. 32, lines 53-67, cols. 33 and 34 and col. 35, lines 1-25).

Claims 37-41, 43, 48-49, 55, 57, 64 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated Zhong et al. (US 6,635,078).

Zhong et al. disclose a system including: a delivery instrument 100 including an expandable element 108 at a distal end thereof; an expandable device 112 removably mounted to the expandable element 108 (Figs. 1-4, col. 3, lines 42-67, cols. 4-6 and col. 7, lines 1-19).

It is further noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.


Art Unit: 3733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

June 24, 2007


ANURADHA RAMANA
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700